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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/736,631

12/17/2003

Hiroaki Imai

500.433-40X00

3845

20457

7590

06/24/2009

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EXAMINER

AMSDOLL, DANA

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

06/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/736,631

Applicant(s)

IMAI ET AL.

Examiner

DANA AMSDELL

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-8, 10-12, and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-8, 10-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB008)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. 35 U.S.C. §101 Rejection

Applicant's arguments, see Remarks filed 3/24/2009, with respect to the rejection(s) of claim(s) 8 and 9 under 35 U.S.C. 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

2. 35 U.S.C. §102(b) Rejection

Applicant's arguments with respect to claims 1, 7, 8 and 10 have been considered but are moot in view of the new ground(s) of rejection. Amendments to claims to reflect the "object of the present invention" to be .." promote repeated use of a product and provide a service according to it. However in order to achieve the aforementioned object the sale staff needs to provide the consumer with the product first" is rejected as follows in the immediate Office action.

In response to applicant's argument that in essence, the art taught by Nagata does not teach to what the Applicant regards as the object of the immediate invention, Examiner respectfully responds is that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 7 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1—2, 4, 6-8 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata (US 2002/0077979) herein "Nagata"; in view of Junger (US 7379899) herein "Junger".

6. Regarding claims 1, 7 and 8, directed to providing appropriate services to a user of a repeated use of a product such as a commodity vessel or a commodity Nagata teaches:

- second judging judges whether a writable storage medium is attached to the product; wherein when the step of second judging judges that the product has no writable storage medium attached thereto, a step of attaching a writable storage medium to the product presented upon purchase of the commodity or service and writing information as to initial use in the attached writable storage medium (¶¶ 0108 and ¶¶ 0295);
- reading storage information from the writable storage medium which is attached to the product, when the user presented the product with the writable storage

medium attached thereto presented by the product user (Fig. 1, block 10, elms. 5, 60/61; and ¶0411);

- recognizing the use history of the product from the storage information acquired (Fig. 35, elm. 92)
- judging the service content by checking the use history recognized in a table where service content is defined according to the number of repeated uses of the product (Fig. 76(a), 'recycle rounds'; and ¶0998);
- executing a processing according to the service content judged and outputting the processing result to an output apparatus (Fig. 76(a); Fig. 89, elm. 125; ¶0264 and ¶1055);
- writing information as to reuse in the writable storage medium that the process corresponding to the executed service content has been performed by the step of executing (¶0010 and ¶0464).

Nagata is silent to the judging of whether a product is presented; judging that no product is presented; and providing a product when none is presented tracking sales. Junger however, teaches judging whether the product is presented by the user upon purchase of the commodity or service (Fig. 2, steps 100/102);

wherein when the judging judges that no product is presented by the product user upon purchase of the commodity or service providing the product (Fig. 2, steps 102/114), (Fig. 2, step 114/100). One of ordinary skill in the art would find it obvious to modify the teachings of Nagata by the features disclosed by Junger to encourage sales of reusable products and facilitate control of the process as early as the inception of initial purchase

thus providing an aggressive ecological approach to a more widespread utility of re-usable items.

7. Regarding claim 2, Nagata and Junger combined to the claim dependencies, and Nagata further teaches wherein instructing the reader/writer section to write a use history in the writable storage medium according to a commodity or a service when the presentation of the product by the product user is upon a commodity or service purchase accompanied by the repeated use of the product (Fig. 34, steps 30/37/38; and Fig. 78).

8. Regarding claim 4, Nagata and Junger combined to the claim dependencies, and Nagata further teaches:

- a step of attaching the writable storage medium to the product presented upon purchase of the commodity or service when the product has no writable storage medium attached thereto (¶ 0108 and ¶ 0295); and

a step of instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content (¶ 0573).

9. Regarding claim 6, Nagata and Junger combined to the claim dependencies, and Nagata further teaches:

a step of providing the product having the writable storage medium attached thereto when no product is presented by the product user upon purchase of the commodity or service; and a step of instructing the reader/writer section to write the use history into the writable storage medium attached to the provided product according to the commodity or service purchase content (Fig. 9(a); 10(a); and ¶¶0314-¶0315).

10. Regarding claims 14 and 15 Nagata and Junger combined to the claim dependencies, and Nagata further teaches the method and computer directed to a table to be used at the step of judging the service content is stored at a location other than the writable storage medium (Fig. 15., elm 161; Fig 76 (a) and ¶0286).

11. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata, in view of Naka (US 2002/0038222), herein "Naka".

12. Regarding claim 10 directed to a device for providing services to a user who is repeatedly using a vessel for containing a commodity to purchase the commodity, Nagata teaches said device comprising:

a computer section;

- a reader/writer section connected to the computer section and capable of reading/writing information stored in a readable/writable storage medium; and
- a memory section connected to the computer section and capable of storing services to the user having different contents according to a number of repeated

uses of the vessel (Fig. 4 and Fig 55);
wherein when the reader/writer section detects the readable/writable storage medium which is attached to the vessel, the computer section calculates a latest number of repeated uses of the vessel from the information in the readable/writable storage medium attached to the vessel (§¶0123 and ¶0998); and
wherein the computer section decides a service to be provided to the user corresponding to the latest number of repeated uses by referencing the memory section and enables execution of the decided service; and
wherein the computer section writes information as to reuse in the readable/writable storage medium when the decided service has been executed (Fig. 34 and ¶0401).

Nagata is silent to specific limitation of when no vessel is presented by the vessel user upon purchase of the commodity or service, the reader/writer section provides the vessel having writable storage medium attached thereto;
wherein the computer section executes processing to attach the readable/writable storage medium to the vessel when the reader/writer section does not detect that the readable/writable storage medium is attached to the vessel; and
wherein the computer section writes an initial use information in the readable/writable storage medium when the readable/writable storage medium gets attached to the vessel. However, Naka does disclose a service management system that performs as claim recites (see 'Abstract'; Fig. 2 and ¶0049). One of ordinary skill in the art, would find it obvious to modify the teachings of Nagata to include these features disclosed by

Naka to enable entry into the vessel use cycle at a variety of junctures, thus increasing flexibility of sales, re-sales and re-use.

13. Regarding claim 11, Nagata and Naka teach the claim dependencies, and Nagata teaches further wherein the computer section reads a number of repeated uses of the vessel in the past from the information in the readable/writable storage medium attached to the vessel and overwrites the latest number of repeated uses on the number of repeated uses of the past in the readable/writable storage medium ((Fig. 679a0; and ¶0996).

14. Regarding claim 12, Nagata and Naka teach the claim dependencies, and Nagata teaches further wherein the readable/writable storage medium is embedded in a thickness of the vessel.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagata and Junger as applied to claim 7 above, and further in view of Naka.

16. Regarding claim 16, Nagata and Junger combined to the claim dependencies, and Nagata further teaches instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content (Fig. 4). Yet, both Nagata and Junger are silent to the means for attaching the writable storage medium to the product presented upon purchase of the

commodity or service when the product has no writable storage medium attached thereto; and means for; wherein the reader/writer section executing the read operation determines whether or not the product has the writable storage medium attached thereto. Naka however is not (see 'Abstract'; Fig. 2; ¶0049 and Fig. 12). One of ordinary skill in the art, would find it obvious to modify the teachings of Nagata and Junger to include these features disclosed by Naka to enable entry into the vessel use cycle at a variety of junctures, thus increasing flexibility of sales, re-sales and re-use.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Swartz et al. US 5594228
- Heuft et al. US 6732921
- Suetake US 2002/0042737

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA AMSDELL whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627